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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,031	08/20/2001	Mary A. Ericksen	56091US002	7794

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/934,031	Applicant(s) ERICKSEN, MARY A. 7A	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,15-28,30-33 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,23-28,30-33,36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 15-22 and 38-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2004 has been entered.

Election/Restrictions

2. Newly submitted claims 38 – 41 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims are directed towards the method of using a tape to form a retroreflective instead of the retroreflective article.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38 – 41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. Claims 1, 31 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "comfortably" in claims 1, 31 and 37 is a relative term, which renders the claim indefinite. The term "comfortably" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. "Comfortably" is a relative since there is no basis of what is considered to be comfortable. Is "comfortably" being used to describe the actual attachment of the tape to the skin, or it is also dealing with removing of the tape?

Clarification/correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 5, 23, 24, 25, 30 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by May (USPN 4,648,689).

May discloses a tape with an adhesive side (Figure 2, #3 and Column 3, lines 38 – 39) and a non-adhesive side (Figure 1, #4) where the adhesive is a pressure sensitive adhesive (Column 5, lines 13 – 18) which sticks to the surface to which it is applied (Column 5, lines 19 – 24), which is capable of being adhered to human skin since it is a tape with an adhesive on one side. The tape is formed with a backing material having a layer chosen from a closed-cell cross-

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linked foam material chosen from a variety of materials including polyurethane, silicone rubber, ethylene propylene diene terpolymer or neoprene (Column 3, lines 34 – 37) or a non-woven material made from fiberglass fibers (Column 3, lines 56 – 57). Due to the open claim language and the definition of backing, it is believed that the tape may be made from multiple layers of material. A layer of reflective microspheres, glass beads with an aluminum coating (Column 3, lines 47 – 49), are attached to the non-adhesive side of the tape by embedding the spheres in the surface of a polymeric sheet which is attached to the backing material of the tape (Column 3, lines 44 – 47).

With regard to the limitation of the tape being a medical tape in claims 4 and 5, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The limitations of “coating the first side of the foam backing”, “covering the second side of the foam backing” and applying heat and pressure to partially embed the retroreflective beads” in claims 24 and 25 are process limitations. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the limitations of coating, covering and applying heat pressure are

methods of production and therefore do not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself.

MPEP 2113.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 – 8, 26 – 28, 31 – 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over May (USPN 4,648,689).

May discloses a tape with an adhesive side (Figure 2, #3 and Column 3, lines 38 – 39) and a non-adhesive side (Figure 1, #4) where the adhesive is a pressure sensitive adhesive (Column 5, lines 13 – 18) which sticks to the surface to which it is applied (Column 5, lines 19 – 24), which is capable of being adhered to human skin since it is a tape with an adhesive on one side. The tape is formed with a backing material having a layer chosen from a closed-cell cross-linked foam material chosen from a variety of materials including polyurethane, silicone rubber, ethylene propylene diene terpolymer or neoprene (Column 3, lines 34 – 37) or a non-woven material made from fiberglass fibers (Column 3, lines 56 – 57). Due to the open claim language and the definition of backing, it is believed that the tape may be made from multiple layers of material. A layer of reflective microspheres, glass beads with an aluminum coating (Column 3,

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lines 47 – 49), are attached to the non-adhesive side of the tape by embedding the spheres in the surface of a polymeric sheet which is attached to the backing material of the tape (Column 3, lines 44 – 47).

One of ordinary skill in the art would have recognized the claimed retroreflective article would have a reflective brightness of the beads would be greater than 70 or 90% after 750 or 5,000 abrasion cycles since May teaches foam articles with glass beads embedded in the surface. Therefore, one of ordinary skill in the art would have readily determined the optimum reflective brightness after the abrasion cycles depending on the end desired results in the absence of unexpected results.

With regard to the limitation of the tape being a medical tape in claims 31 and 37, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Response to Arguments

9. Applicant's arguments with respect to claims 1, 4 – 8, 23 – 28, 30 – 33, 36 and 37 have been considered but are moot in view of the new ground(s) of rejection. However, since the May reference was used in the new rejection above, pertinent arguments will be responded to below.

In response to Applicant's argument that there is no motivation or suggestion that the microspheres taught by May should be embedded in the foam body, the claim language in the application is open language, i.e. comprising, and the definition of backing is very general, thereby allowing for other layers of materials to be present in the tape material. Therefore, the polymer sheet with the beads embedded in the surface and attached to the foam layer of the tape meets the limitations of the claims. Also, the claim language does not distinctly claim that the retroreflective beads are embedded in the foam body of the tape. The claim states that the beads are embedded in the non-adhesive side of the tape, and there is no reference as to where the backing material of claims 4 and 5 is located within the structure of the tape, nor is it clearly stated what the backing material is in the tape of claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

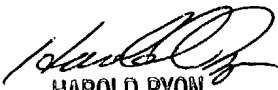
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/28/04